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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/670,113  | 09/26/2000  | William Y. Conwell   | 60299               | 4862             |
| 23735   | 7590        | 08/01/2003           | EXAMINER            |                  |
| DIGIMARC CORPORATION<br>19801 SW 72ND AVENUE<br>SUITE 100<br>TUALATIN, OR 97062 |             |                      | PATEL, SHEFALI D    |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 2621                 | 3                   |                  |
| DATE MAILED: 08/01/2003   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                             |                     |
|------------------------------|-----------------------------|---------------------|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)        |
|                              | 09/670,113                  | CONWELL, WILLIAM Y. |
|                              | Examiner<br>Shefali d Patel | Art Unit<br>2621    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2000.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Note: Applicant discloses the reference on page 1 lines 8-10.

### ***Drawings***

2. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

### ***Specification***

3. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.  
(1) Field of the Invention.  
(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.  
(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).  
(h) DETAILED DESCRIPTION OF THE INVENTION.  
(i) CLAIM OR CLAIMS (commencing on a separate sheet).  
(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).  
(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 line 4, "encoding a watermark in a representation of said image" is indefinite because it fails to mention which "representation" of the image the watermark is being encoded in.

Claim 3 line 5, "associating with said watermark" fails to mention what is being "associated" with the watermark. Please Specify.

Claim 3 does not end with a period. Each claim must begin with a capital letter and must end with a period (See MPEP 608.01(m)).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhoads (USPN 5,841,886).

With regard to **claim 1** Rhoads discloses a method comprising receiving data corresponding to an image, the image including a depiction of text (See column 6 lines 58-63, here the document 1000 includes the image at 1010 and text at 1012, as also seen in Figure 6); and decoding (by extracting identification code from the photo, See col. 7 lines 37-38) a digital watermark (i.e., embedded code signal in a digital image at col. 7 line 36) from the image data (See column 7 lines 37-39); and by reference to said digital watermark, accessing (extracting identification code from the photo using decoding techniques at col. 7 lines 37-38) at least some of said depicted text in non-image form (“at least some of said depicted text in non-image form” is the N-bit identification code embedded in the image portion of the document 1000, See column 7 lines 33-37).

With regards to **claim 2** Rhoads discloses an index to a collection of electronic objects at least one of said objects comprising an image depicting text, formed by use of the method of

claim 1 as discloses at column 1 lines 61-67. Note, Rhoads clearly states that the invention disclosing multi-bit data can serve as a serial number index into a database.

With regard to **claim 3** Rhoads discloses a method comprising receiving data corresponding to an image, the image including a depiction of text (See column 6 lines 58-63, here the document 1000 includes the image at 1010 and text at 1012, as also seen in Figure 6); generating a non-image representation of at least some of said depicted text (note, by extracting identification code from the photo by using the decoding techniques described, non-image representation of the text is being generated. See column 7 lines 29-40); encoding a watermark (i.e., embedded code signal in a digital image at col. 7 line 36) in a representation of said image; and associating with said watermark (See column 7 lines 41-46).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Yamadaji (USPN 6,192,138).

With regard to **claim 4** Rhoads discloses a method of encoding/decoding a digital watermark (i.e., embedded code signal in a digital image at col. 7 line 36) generating a non-image representation of at least some of said depicted text as mentioned above in paragraph 10. However, Rhoads does not expressly disclose that the non-image representation comprises

ASCII text. Yamadaji discloses non-image representation comprising ASCII text (See column 8 lines 62-67). Rhoads and Yamadaji are combinable because they are from the same field of endeavor, i.e., digital watermark. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Yamadaji with Rhoads. The motivation for doing so is that encoding text with ASCII standard is well known in the art. By using the ASCII representation, the processing time and the storage size is reduced. Therefore, it would have been obvious to combine Yamadaji with Rhoads to obtain the invention as specified in claim 4.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 6389151 – See abstract, Fig.1, and column 2-4. 102(e) reference.

USPN 4908873 – Document reproduction security system, col. 2-4.

USPN 6243481 – Information embedding and retrieval method and apparatus, col. 4-6.

USPN 5761686 – Embedding encoded information in an iconic version of a text image.

USPN 6067553 – Image data transfer system using object reference table.

Zhao, "A. WWW Service to Embed and Prove Digital Copyright Watermarks,"

Fraunhofer Institute for Computer Graphics, Proc. of EU Conf. on Multimedia

Applications, Services and Techniques, May 1996, 15 pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali d Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Shefali Patel  
July 17, 2003



Daniel Mariam  
Primary Examiner  
Art Unit 2621